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09/611,905	07/07/2000	Bertram V. Burke	EPC-8C	7723

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EXAMINER

AKERS, GEOFFREY R

ART UNIT

PAPER NUMBER

2164

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/611905

Applicant(s)

Brake

Examiner

Mars, S

Group Art Unit

2164

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/2/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5 and 15-31 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5 and 15-31 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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SUPPLEMENTAL DETAILED ACTION

1. This Supplemental Detailed Action is issued to include Applicant's Amendment A which was not included in the file when the First Office Action was issued. On amendment, claims 1-5 were amended and new claims 15-31 were added. Claims 1-5 and 15-31 are now pending.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because the declaration is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a). It does not include the notary's signature and it does not include the notary's seal and venue.

Drawings

3. The drawings are objected to because the margins are too wide. Correction is required.

Specification

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-3 are rejected under 35 USC 103(a) as unpatentable over Lawlor(US Pat. No: 5,220,501).

7.(AMENDED) As per claim 1, Lawlor teaches a method of accumulating credits in payor surplus accounts from financial transactions between a payor and payee(col 10 lines 35-41)(col 34 lines 5-30)(col 34 lines 41-48). Lawlor teaches entering a tendered amount into a station of a network controlled by the payee(col 41 line 65-col 42 line 2) including paying a bill in the future(Fig 14B/536)(col 44 lines 38-41) as well as paying a bill periodically(Fig 14C/564) and providing ahead of time the names, account numbers, etc of payees that the user desires to pay bills to electronically(col 42 line 68-col 43 line 6). Lawlor also teaches displaying a status of the available funds in the payor's account which does not include the previously scheduled payment amounts, as well as transmitting the additional amount to a separate station forming part of the network controlled by other than the payee and within the separate station, crediting at least part of the additional amount into one or more of the payor surplus accounts determined by the payor to enter a desired payment amount(col 48 lines 1-7)(Fig 17B/696). Lawlor teaches paying additional bills(col 49 lines 44-48) as well as transferring funds between accounts(col 49 lines 48-50). Finally, Lawlor teaches depositing funds into an account to pay bills now(Fig 20C)(col 50 lines 40-59) or in the future(col 50 line 64-col 51 line 5). Lawlor does not specifically teach the use of a "surplus" account. It would have been obvious to one skilled in the art at the time of the invention that transfer of funds between accounts, the payment of additional bills, the utilization of future payment dates and depositing of funds into an account to pay bills now or in the future as

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taught by Lawlor permits the creation of a surplus account for accumulating credits in such account from financial transactions between a payor and a payee.(col 51 line 67-col 52 line 15).The motivation for this is to teach a method for crediting additional payments from a payor to a payee.

8.(AMENDED) As per claim 2, Lawlor teaches the method as in claim 1 wherein the step of transmitting the additional amount includes the step of the payee crediting the amounts to the payor surplus account in the separate station of the network(central clearing entity) so that the payee remains neutral to the amounts(col 20 lines 62-66)(col 11 lines 61-65).Lawlor fails to teach that these electronic payments are specifically “additional amounts”. It would have been obvious to one skilled in the art at the time of the invention that transfer of funds between accounts, the payment of additional bills, the utilization of future payment dates and depositing of funds into an account to pay bills now or in the future as taught by Lawlor as well as the fact that electronic payments may also include any sums as well as additional amounts permits the creation of a surplus account for accumulating credits in such account from financial transactions between a payor and a payee.(col 51 line 67-col 52 line 15).The motivation for this is to teach a method for crediting additional payments from a payor to a payee.

9.(AMENDED) As per claim 3, Lawlor teaches a method as in claim 2 further comprising the step of printing out the status of said surplus account(col 7 lines 56-63).

10. (NEW)As per claim 15, Lawlor teaches a method wherein said step of entering a base

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amount from at least one transaction between a first party and a second party and the step of changing the balance of an operating account of the first party on the basis of the amount of at least one transaction and a step of adjusting the balance of the operating account on the basis of the at least one transaction to form a rounder amount and the balance of the first party of the balance of the least one rounder account of the first party on the basis of the adjustment(col 15 lines 34-47)(col 35 lines 16-36).Lawlor fails to state specifically that this is a “surplus” account.It would have been obvious to one skilled in the art at the time of the invention that transfer of funds between accounts, the payment of additional bills, the utilization of future payment dates and depositing of funds into an account to pay bills now or in the future as taught by Lawlor as well as the fact that electronic payments may also include any sums as well as additional amounts permits the creation of a surplus account for accumulating credits in such account from financial transactions between a payor and a payee.(col 51 line 67-col 52 line 15).The motivation for this is to teach a method for crediting additional payments from a payor to a payee.

11.(NEW) As per claim 16 Lawlor teaches a method as in claim 15 where the adjusting step is performed after each changing step(col 33 line 51-col 34 line 28).

12.(NEW) As per claim 17 Lawlor teaches a method as in claim 15 where the adjusting step is performed after a plurality of changing steps(col 34 lines 41-col 35 line 2).

13. (NEW) As per claim 18 Lawlor teaches a method as in claim 15 wherein the step of adjusting the base amount occurs on contents of instructions entered by the first party(col 41 line 61-col 43 line 8).

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14.(NEW) As per claim 19 Lawlor teaches a method as in claim 15 wherein the system is a computer system(Abstract)(Fig 1A).

15.(NEW) As per claim 20 Lawlor teaches a method as in claim 15 wherein each entering step is performed by the second party to the transaction and the changing and adjusting steps are performed outside of the control of the second party(Fig 1A/80E)(col 20 lines 7-67).

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 21-31 are rejected under 35 USC 102(b) as anticipated by Lawlor(US Pat. No: 5,220,501).

18. (NEW) As per claim 21 Lawlor teaches a method of modifying data in a surplus account from a financial transaction between a payor and a payee, comprising entering data that identifies a credit or a debit amount of a separate network controlled by other than the payee(col 20 lines 44-54) and transmitting the data that identifies the credit or debit amount of a separate network controlled by other than the payee(col 20 lines 54-58)(Fig 1A/80G/80F/88) and within the separate network, modifying the data associated with one or more payor surplus accounts

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selected by the payor as a credit or debit(col 20 line 59-col 22 line 15) and transferring any data representing a debit back to the payee(col 21 line 53-col 22 line 15).

19.(NEW) As per claim 22 Lawlor teaches a method according to claim 21 wherein said entering of data occurs at a point of sale(col 21 line 53-col 22 line 22).

20.(NEW) As per claim 23 Lawlor teaches a method as in claim 21 where the transmitting of data is performed after each entering step(col 22 lines 28-32).

21.(NEW) As per claim 24 Lawlor teaches a method as in claim 21 where the transmitting of data occurs after a plurality of entering steps(col 21 lines 57-63).

22.(NEW) As per claim 25 Lawlor teaches a method as in claim 21 wherein the step of modifying the data includes selecting the one or more surplus accounts based on instructions that are entered in the system by said payor and that accompany the entering of data(col 22 lines 16-62).

23.(NEW) As per claim 26 Lawlor teaches a method as in claim 21 wherein said transmitting of the data is performed by the payee, and the modifying and transferring are performed outside of the control of the payee(Fig 1A/80E/88)(col 19 line 20-col 20 line 58).

24.(NEW) As per claim 27 Lawlor teaches a method as in claim 22 wherein said entering and transmitting are performed by the payor and the modifying and transferring are performed by a third party other than the payee(col 22 line 44-col 23 line 56)(col 18 lines 60-61).

25.(NEW) As per claim 28 Lawlor teaches a method as in claim 21 wherein the separate satation controlled by other than the payee,handles both data and cash(col 21 line 11-col 22 line 22)(col 19 line 57-col 20 line 6).

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26. (NEW) As per claim 29 Lawlor teaches a method as in claim 21 wherein entering the data includes first entering data that identifies a credit amount into a surplus account at the station controlled by the payee and at a later time entering data that identifies a debit amount into a station controlled by the payee(col 18 line 26-50)(col 21 lines 11-46)(col 22 lines 16-21).

27.(NEW) As per claim 30 Lawlor teaches a method as in claim 21 wherein said surplus account is an existing surplus account(col 10 lines 35-41)(col 34 lines 5-30)(col 34 lines 41-48)(Fig 20C)(col 50 lines 40-59)(col 50 line 64-col 51 line 5).

28.(NEW) As per claim 31 Lawlor teaches a method as in claim 21 wherein entering the data into a surplus account occurs at multiple unrelated payees (Fig 20C)(col 50 lines 40-59)(col 50 line 64-col 51 line 5)(col 51 line 67-col 52 line 15)(col 48 lines 1-7)(Fig 17B/696)(col 49 lines 44-48).

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29.(AMENDED) Claims 4-5 are rejected under 35 USC 103(a) as unpatentable over Lawlor(US Pat. No: 5,220,501) in view of Heibling(US Pat. No: 5,546,303) and further in view of Bush(US Pat. No: 5,475,585).

30. As per claims 4-5, Heibling teaches a method as in Claim 1, wherein said surplus account includes sub accounts identifying a plurality of charities(col 2 lines 16-19)(col 2 lines 25-37)(col 4 lines 28-43)(col 4 lines 47-51)(Fig 1/47/48), bank(Fig 1/44) and other sub accounts and Bush teaches depositing the additional amount via a menu selection which includes assigning predetermined portions of said surplus account to said sub accounts(col 3 lines 21-49)(Fig 1-A/12/14/16/30).Bush further teaches making deposits into a number of sub accounts(Fig 8/301/302/303/304).It would have been obvious to one skilled in the art at the time of the invention to combine Lawlor in view of Heibling to teach the above. The motivation to combine is to teach an improved method for the correlation of charitable contributions in conjunction with businesses as enunciated by Heibling(col 2 lines 1-4). Furthermore, it would also have been obvious to one skilled in the art at the time of the invention to combine Lawlor in view of Heibling and further in view of Bush. The motivation to combine is to teach a real time transactional processing system for consumer transactions for a wide variety of services and products as enunciated by Bush(col 1 lines 14-16).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified

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or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

31. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in the public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

32. Claims 1-5,29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,112,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

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33. Claim 1 of the instant application essentially repeats most of the features listed in Burke, claim 1 (col. 18, lines 15-24). There are several changes, namely: the deletion of the recitations in the claim of “into a station of a network controlled by the payee” and “into a station of a network controlled by other than the payee and within the station apportioning the data determined by the payor” in the instant application does not change the structural operation of accumulating credits in a payor surplus account from financial transactions between a payor and a payee.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claim 1, the deletion of the recitation in the claim of “into a station of a network controlled by the payee” and “into a station of a network controlled by other than the payee and within the station apportioning the data determined by the payor” from the patented claim would have been an obvious expedient as above.

34. Claim 2 of the instant application essentially repeats most of the features listed in Burke, claim 2 (col. 18, lines 25-32). There are several changes, namely: the deletion of the recitations in the claim of “the step of transmitting the data of the additional amount” and “in the separate station of the network” in the instant application does not change the structural operation of crediting the additional amount to the surplus account in the hands of a central clearing entity so that the payee remains neutral to these additional amounts.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. In instant claim 2, the

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deletion of the recitation in the claim of “ the step of transmitting the data of the additional amount” and “in the separate station of the network” from the patented claim would have been an obvious expedient as above.

35. Claim 3 of the instant application essentially repeats most of the features listed in Burke, claim 5 (col. 18, lines 42-45). There are several changes, namely: the deletion of the recitations in the claim of “ one or more ”in the instant application does not change the structural operation of entering an additional amount which includes calculating the additional amount from the predetermined data associated with the surplus account.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. In instant claim 3, the deletion of the recitation in the claim of “ one or more” from the patented claim would have been an obvious expedient as above.

36. Claims 4 and 5 of the instant application essentially repeats most of the features listed in Burke, claims 7,14,33. There are several changes, namely: the deletion of the recitation in the claim of “ one or more” in the instant application does not change the structural operation of identifying a plurality of charities, bank and other sub accounts and depositing the additional amount which includes assigning predetermined portions of the said surplus account to the sub accounts.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. In instant claim 5, the

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deletion of the recitation in the claim of "one or more" from the patented claim would have been an obvious expedient as above.

37. Claim 3 is identical to the patented claim 3.

38. Claim 29 is patently similar to patented claim 1.

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Ohmae teaches a system for making payments for transactions

-Smith teaches an automated funds collection system

40. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703)-308-6296 or 6306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3900.

GRA

April 11, 2002